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Claes Persson

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466 7590 04/27/2009
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EXAMINER

GRANO, ERNESTO ARTURIO

ART UNIT

PAPER NUMBER

3728

MAIL DATE

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04/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,584	Applicant(s) PERSSON, CLAES	
	Examiner ERNESTO A. GRANO	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of Applicant's amendment filed on 12/29/2008.
 - Claim 10 was canceled.
 - Claim 21 was added.
 - Claims 1-9 and 11-21 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-9 and 11-21 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74

(Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1, line 3 recites the broad recitation damage, and the claim also recites inadvertent erasure of data which is the narrower statement of the range/limitation.

Claim 1 further recites the phrase "and/or" in line 3 which is indefinite and should be replaced by "at least one of...and..." in each instance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is finally rejected under 35 U.S.C. 102(b) as being anticipated by Miller (US 5,524,750).

In re claim 1, with reference to figure 1, Miller discloses a device **for** storing and protecting a card having an electronic data-carrying element from inadvertent erasure of data and/or other damage, comprising:

- a holder 10, **configured to** contain a card 15 comprising an electronic data-carrying element, the card 15 having a card width and a card length being longer than said card width, and the card being any one of

a bank card, key card, membership card, cash card, and payment card
(see figure 1)

- the holder 10 comprised of shielding metal sheets **configured to** envelop the data-carrying element of the card, the metal sheets of the holder being produced from one uniform piece of sheet material that is bent or folded at a fold such that the holder has the form of a first sheet portion 22, and a second parallel sheet portion 24 connected to the first sheet portion 22 via the fold, the second sheet portion 24 being connected to the first sheet portion 22 at a distance from the first sheet portion 22 **corresponding approximately** to a thickness of the card **to be** protected (see column 2, lines 1-14)
- wherein an area of the first sheet portion 22 is **configured to** completely overlap the whole surface area of the card 15 if placed on the surface, wherein an area of the second sheet portion 24 is **configured to** completely overlap the data-carrying element of the card 15, upon the card 15 being fully inserted into the holder (see figure 1)
- wherein the area of the second sheet portion 24 is further **configured to** extend a distance from the fold such that a surface of the card 15, extending over the entire card length, is exposed and not overlapped by the second sheet portion 24 (see figure 1)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-9, and 11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 5,524,750) as applied to claim 1 above.

In re claims 6-7, Miller as applied to claim 1 above, discloses the claimed invention but fails to expressly disclose a metal shielding sheet made of electrical steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use any metal as the rigid shielding sheet, since rigid electrical steel metal was a known metal material and it is generally within the knowledge of one having ordinary skill in the art at the time the invention was made to include any type of metal that was available, including transformer sheet (e.g. "Electrical Steel"). Note, applicant admits that transformer sheet metal was a known material at the time of the invention and was commercially available from Nippon Steel (see page 4, lines 24-25). It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Furthermore, In re claims 8, 9, and 11, Miller as applied to claim 1 above, discloses the claimed invention except for the claimed thickness.

It has been held that, where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than a prior art device, the claimed device is not patentably distinct from the prior art device. *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

8. Claims 4-5, 18-19, and 21 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 5,524,750) as applied to claim 1 above, in view of Wen Chi HU (FR 2,638,619).

In re claim 4, with reference to figure 1, Miller as applied to claim 1 above, discloses the claimed invention except for wherein the holder is equipped with a suitable cleaning layer on the inner surface of at least one of the sheets.

Wen Chi Hu teaches a device capable of storing and protecting a card (2), in the form of a holder (1) comprising shielding sheets (1) so arranged that they can envelop a data-carrying element (21), sheets of the holder (1) are produced from one uniform piece of sheet material (see figure 3) that is bent or folded so that the holder (1) has the form of a first sheet portion (1), and a second, parallel sheet portion (1) connected to the first sheet portion (1) via the fold (11), and wherein the first sheet portion (1) in terms of area is dimensioned so that it is essentially capable of completely overlapping the whole surface area of a card (2), depending on its size, and the second sheet portion (11) in terms of area is dimensioned so that it is capable of completely overlapping the

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data-carrying element (21), depending on its size, which can be in the form of a magnetic strip and/or a chip, integrated circuit, arranged on or in the card (2), if a card is fully inserted into the holder, (1) (see figure 3) and discloses wherein the holder is equipped with a suitable cleaning layer on the inner surface of at least one of the sheets.

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the inner surface of Miller as applied to claim 1 above, with a suitable cleaning layer as taught by Wen Chi Hu in order to keep the card from getting damaged when being held.

In re claim 5, with reference to figure 3, Wen Chi Hu ('619) as applied to claim 1 above, discloses wherein the cleaning layer is made of a suitable relatively soft rubber material, felt material or the like.

In re claims 18-19, Miller / Wen Chi Hu as applied to claims 4 and 5 above, discloses the claimed invention but fails to expressly disclose a metal shielding sheet made of electrical steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use any metal as the rigid shielding sheet, since metal was a known material and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Furthermore, it is generally within the knowledge of one having ordinary skill in the art at the time the invention was made to include any type of metal that was available, including transformer sheet (e.g. "Electrical Steel"). Note, applicant admits

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that transformer sheet metal was a known material at the time of the invention and was commercially available from Nippon Steel. (see page 4, lines 24-25)

In re claim 21, Miller / Wen Chi Hu as applied to claim 4 above,, discloses wherein the data-carrying element capable of being any of a magnetic strip and a microchip.

9. Claims 2, 12, 16 and 20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 5,524,750) as applied to claim 1 above, in view of Littman (US Patent 3,027,995).

In re claim 2, with reference to figure 3, Miller (US 5,524,750) as applied to claim 1 above, discloses the claimed invention except for wherein that the holder on its external plane sides has applied thereto a layer or coating.

However, Littman ('995) teaches a combination money clip and article holder which is formed by a single sheet of metal that can be chrome plated or plated with other ornamental metal. (see column 2, lines 4-6)

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the external plane side of Miller (US 5,524,750) as applied to claim 1 above, with chrome or another ornamental metal as taught by Littman ('995) in order to give the holder a more appealing look.

In re claim 12, with reference to figure 1, Littman ('995) discloses wherein the coating is commonly known to be a wear-resistant material. (see column 2, lines 4-6)

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In re claim 16, Miller / Littman as applied to claim 2 above, discloses the claimed invention but fails to expressly disclose a metal shielding sheet made of electrical steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use any metal as the rigid shielding sheet, since metal was a known material and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Furthermore, it is generally within the knowledge of one having ordinary skill in the art at the time the invention was made to include any type of metal that was available, including transformer sheet (e.g. "Electrical Steel"). Note, applicant admits that transformer sheet metal was a known material at the time of the invention and was commercially available from Nippon Steel. (see page 4, lines 24-25)

In re claim 20, Miller / Littman as applied to claim 2 above, discloses the claimed invention except for wherein the shielding metal has a thickness in the range of 0.25 - 1.0 mm.

It has been held that, where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than a prior art device, the claimed device is not patentably distinct from the prior art device. *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

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10. Claim 13 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Miller / Littman as applied to claim 12 above, and in further view of Kamens et al. (US Patent 5,941,375).

In re claim 13, Miller / Littman as applied to claim 12 above, discloses the claimed invention except for wherein the coating is one of an elastomer and a suitable plastic material.

However, Kamens et al. ('375) teaches a protective card case comprising a plastic covered magnetic shielding metal for holding a card having a magnetically encoded strip. (see column 4, lines 59-67 and column 5, lines 1-4)

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the cover layer of Miller / Littman as applied to claim 12 above, with a plastic coating as taught by Kamens et al. ('375) in order to have a more appealing case that can come in a variety of different plastic colors.

11. Claim 14 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Miller / Littman as applied to claim 2 above, and in further view of Wen Chi Hu (FR 2,638,619).

In re claim 14, Miller / Littman as applied to claim 2 above, discloses the claimed invention except for wherein the holder is equipped with a suitable cleaning layer on the inner surface of at least one of the sheets.

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Wen Chi Hu teaches a device capable of storing and protecting a card (2), in the form of a holder (1) comprising shielding sheets (1) so arranged that they can envelop a data-carrying element (21), sheets of the holder (1) are produced from one uniform piece of sheet material (see figure 3) that is bent or folded so that the holder (1) has the form of a first sheet portion (1), and a second, parallel sheet portion (1) connected to the first sheet portion (1) via the fold (11), and wherein the first sheet portion (1) in terms of area is dimensioned so that it is essentially capable of completely overlapping the whole surface area of a card (2), depending on its size, and the second sheet portion (11) in terms of area is dimensioned so that it is capable of completely overlapping the data-carrying element (21), depending on its size, which can be in the form of a magnetic strip and/or a chip, integrated circuit, arranged on or in the card (2), if a card is fully inserted into the holder, (1) (see figure 3) and discloses wherein the holder is equipped with a suitable cleaning layer on the inner surface of at least one of the sheets.

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the inner surface of Miller as applied to claim 1 above, with a suitable cleaning layer as taught by Wen Chi Hu in order to keep the card from getting damaged when being held.

12. Claims 3 and 17 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Miller / Littman as applied to claim 2 above, and in further view of Parker (US Patent 4,792,058).

In re claim 3, Miller / Littman as applied to claim 2 above, discloses the claimed invention except for wherein the layer is provided with distinctive marks in the form of a logo, advertising or other decoration.

However, Parker teaches a pocket-sized dispenser for business or calling cards which includes a case having generally continuous upper and lower surfaces upon which advertising or identification indicia may be displayed and in which the cards are protectively housed for selective dispensing utilizing a reinforced and automatically retracted ejector mechanism. (see abstract)

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the external plane side layer of Miller / Littman as applied to claim 2 above, with advertising or identification indicia as taught by Parker in order to be used by corporations and/ or businesses as effective promotional sources or materials. (see column 5. lines 59-66)

In re claim 17, Miller / Littman / Parker as applied to claim 3 above, discloses the claimed invention but fails to expressly disclose a metal shielding sheet made of electrical steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use any metal as the rigid shielding sheet, since metal was a known material and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Furthermore, it is generally within the knowledge of one having ordinary skill in the art at the time the invention was made to include any type of metal that was

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available, including transformer sheet (e.g. "Electrical Steel"). Note, applicant admits that transformer sheet metal was a known material at the time of the invention and was commercially available from Nippon Steel. (see page 4, lines 24-25)

13. Claims 15 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Miller / Littman / Parker as applied to claim 3 above, and in further view of Wen Chi Hu (FR 2,638,619).

In re claim 15, Miller / Littman / Parker as applied to claim 3 above, discloses the claimed invention except for wherein the holder is equipped with a suitable cleaning layer on the inner surface of at least one of the sheets.

Wen Chi Hu teaches a device capable of storing and protecting a card (2), in the form of a holder (1) comprising shielding sheets (1) so arranged that they can envelop a data-carrying element (21), sheets of the holder (1) are produced from one uniform piece of sheet material (see figure 3) that is bent or folded so that the holder (1) has the form of a first sheet portion (1), and a second, parallel sheet portion (1) connected to the first sheet portion (1) via the fold (11), and wherein the first sheet portion (1) in terms of area is dimensioned so that it is essentially capable of completely overlapping the whole surface area of a card (2), depending on its size, and the second sheet portion (11) in terms of area is dimensioned so that it is capable of completely overlapping the data-carrying element (21), depending on its size, which can be in the form of a magnetic strip and/or a chip, integrated circuit, arranged on or in the card (2), if a card is fully inserted into the holder, (1) (see figure 3) and discloses wherein the holder is

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equipped with a suitable cleaning layer on the inner surface of at least one of the sheets.

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the inner surface of Miller / Littman / Parker as applied to claim 3 above, with a suitable cleaning layer as taught by Wen Chi Hu in order to keep the card from getting damaged when being held.

Response to Arguments

14. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERNESTO A. GRANO whose telephone number is (571)270-3927. The examiner can normally be reached on 7:00am - 4:00pm Mon.-Thur..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bryon P. Gehman/
Primary Examiner, Art Unit 3728

/Ernesto A Grano/
Examiner
Art Unit 3728

EAG

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